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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,981	08/01/2002	MATHIEU HUBERTUS MARIA NOTEBORN	LEBV.006.01U	8208
24247	7590	09/20/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			JOYCE, CATHERINE	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/555,981		NOTEBORN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Catherine M. Joyce		1642	

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. Claims 1-18 are pending.
2. Claim 3-6 and 12 are withdrawn from consideration because they are in improper form under 37 CFR 1.75(c), which states that a multiple dependent claim shall not serve as the basis for any other multiple dependent claim. See MPEP § 608.01(n).
3. Claim 18 is withdrawn from consideration because the metes and bounds of the claim cannot be determined. It cannot be determined if a process claim or a product claim is intended.

### ***Election/Restrictions***

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-2, 7, and 9-11 as drawn to the special technical feature of a recombinant and/or isolated nucleic acid molecules encoding an Nmi/Hou-like protein.

Group II, claims 1-2, 8, and 9-11 as drawn to the special technical feature of a recombinant and/or isolated nucleic acid molecule encoding an IFP35-like protein.

Group III, claims 13-15, as drawn to the special technical feature of an Nmi/Hou-like proteinaceous substance.

Group IV, claim 16, drawn to the special technical feature of an IFP35-like proteinaceous substance.

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Group V, claim 17, as drawn to the special technical feature of a method of inducing apoptosis in cells comprising providing said cells with IFP35-like activity together with apoptin-like activity.

Group VI, claim 17, as drawn to the special technical feature of a method of inducing apoptosis in cells comprising providing said cells with Nmi/Hou-like activity together with apoptin-like activity.

5. The inventions are distinct, each from the other, because of the following reasons:

A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Unity of invention is fulfilled only when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features which define a contribution over the prior art. If there is no special technical feature, if multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3)(a) and 1.476(c), 37 C.F.R. 1.475(d).

The inventions listed as Groups I-VI do not relate to a single inventive concept because they lack the same or corresponding special technical features for the following reasons: Groups I-VI encompass different special technical features, as identified in the groupings above.

Groups with different special technical features, i.e., different categories of inventions, will only be found to meet the Unity of Invention Rule if specific combinations of inventions are present. The allowed combinations consist of one product, one process of making and one process of using of said product related to a single general inventive concept. The allowed combinations do not include multiple products and multiple methods of using said products as claimed in the instant application.

Groups I- IV relate to structurally distinct products and thus do not share a special technical feature. Groups V and VI relate to materially distinct methods which differ at least in objectives, method steps and reagents and thus do not share a special technical feature.

6. Group I is further subject to election of a single disclosed species.

Claim 1 is generic to a plurality of disclosed patentably distinct species comprising a recombinant and/or isolated nucleic acid molecules encoding an Nmi/Hou-like protein. The species are as follows: (a) Hou c6/#1 (as disclosed in the specification in Figure 1); (b) Hou c17/#2 (as disclosed in the specification in Figure 2). The species are patentably distinct because they are directed to structurally distinct nucleic acid molecules.

5. Group II is further subject to election of a single disclosed species.

Claim 1 is generic to a plurality of disclosed patentably distinct species comprising a recombinant and/or isolated nucleic acid molecules encoding an IFP35-like protein. The species are as follows: (a) IFP35 c14/#1 (as disclosed in the specification in Figure 4); (b) ) IFP35 c33/#2 (as disclosed in the specification in Figure 5); (c) IFP35 c51/#3 (as disclosed in the specification in Figure 6). The species are patentably distinct because they are directed to structurally distinct nucleic acid molecules.

6. Group III is further subject to election of a single disclosed species.

Claim 16 is generic to a plurality of disclosed patentably distinct species comprising an IFP35-like proteinaceous substance. The species are as follows: (a) 33ifn (as disclosed in the specification in Figure 7); (b) ) c51 (as disclosed in the specification in Figure 7). The species are patentably distinct because they are directed to structurally distinct proteins.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration

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of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP, 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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12. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine M. Joyce whose telephone number is 571-272-3321. The examiner can normally be reached on Monday thru Friday, 10:15 - 6:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine M. Joyce  
Examiner  
Art Unit 1642

SUSAN UNGAR, PH.D.  
PRIMARY EXAMINER

